



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/041,534	03/12/98	SHORT	J 38701.0001(C)

LM02/0504
BRONSON BRONSON & MCKINNON
444 SOUTH FLOWER STREET, 24TH FLOOR
LOS ANGELES CA 90071-2925

EXAMINER

NGUYEN, S

ART UNIT

PAPER NUMBER

2731

DATE MAILED:

05/04/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/041,534

Applicant(s)

Short et al

Examiner

Steven Nguyen

Group Art Unit

2731



☒ Responsive to communication(s) filed on Mar 12, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-54 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-54 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2731

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1 is rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claim 1 fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in Paper No. 8, lines 10-19 filed 2/8/98. In that paper, applicant has stated a translator connecting between a host device and a communication device. Therefore, the translator device which has a plurality of interface for connecting a host device and a communication device, and this statement indicates that the invention is different from what is defined in the claim(s) because of claim 1, the recitation "an interface for connection to the terminal and to the system" means only one interface for connection to the terminal and to the system.

3. Claim 1, 11, 12, 13, 14, 17, 19, 20, 21, 43 and 44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 11, 12, 13, 14, 17, 19, 20, 21, 43 and 44, the recitation "the system" is vague and indefinite because it does not refer back to any previous elements in the claim.

Art Unit: 2731

There is insufficient antecedent basis for this limitation in the claims.

The applicant should check and correct all 112 second paragraph.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-35 and 37-54 are rejected under 35 U.S.C. 102(b) as being anticipated by Egevang (PUB RFC 1631) and Mayes et al (USP 5793763 used as an extrinsic evidence to show the primary reference contains an enabled disclosure).

Regarding claims 1, 17-30, 32, 34, 37 and 45, Egevang discloses a translator which comprises a plurality of interface for connecting to a terminal and a communication system and a processor which configures to appear as home device to terminal and appear as the terminal to the communication system (Fig 2 discloses a Router with network address translation; router configured as home device to the terminal and as terminal to the communication system. The IP address translations is completely transparent).

Regarding claims 2-5, 9-10, 46-49 and 53-54, Egevang discloses the terminal has a permanent address (IP 10.33.96.5); the translator has a translator address (IP 198.76.29.7); the terminal transmits outgoing data to the communication system including the permanent address as

Art Unit: 2731

a source address; and the processor translates the outgoing data by replacing the permanent address with the translator address as the source address (Page 3, line 1-11, when host want to transmit a outgoing packet to the communication system; the translator replaces the source address with the translator source address).

Regarding claims 6 and 50, it would have been explicit to one of ordinary skill in the art at the time of invention was made to transmit an Address Resolution Protocol (ARP) packet which includes the permanent address to the translator and the processor determines the permanent address from the ARP packet by the terminal.

Regarding claims 7 and 51, Evegant discloses the processor which is configured to operate in a promiscuous mode in which it translates all outgoing data; and the processor determines the permanent address from outgoing data (Page 3 discloses all the outgoing data from the terminal will be translated by the NAT router which determines the permanent address of the terminal).

Regarding claims 8 and 52, it would be explicit to one of ordinary skill in the art at the time of the invention was made to recognize that a translator has its own hardware address and the terminal transmits its outgoing data to the translator address.

Regarding claims 11-12 and 15, it is a designer choice to have the processor automatically configure itself to the communication system and using DHCP or manually configured by user.

Art Unit: 2731

Regarding claim 13, it would have been explicit to one of ordinary skill in the art at the time of the invention was made to recognize the method for accepting all incoming data and extracts system information.

Regarding claim 14, it would have been explicit to one of ordinary skill in the art at the time of the invention was made to have at least one translator which broadcasts information packets including system information and the processor configures itself to the system by receiving and extracting the system information from the information packets.

Regarding claim 16, it would have been explicit to one of ordinary skill in the art at the time of the invention was made to configure a translator to communicate with another translator that is connected to a home device and is configured to function as a home agent.

Regarding claim 31, it is a designer choice to connect a translator to the system without connect to terminal and terminal connects to the communication system.

Regarding claim 33, it would have been explicit to one of ordinary skill in the art at the time of the invention was made to configure the processor to perform the filter function in order to filter the unwanted packet.

Regarding claim 35, it would have been explicit to one of ordinary skill in the art at the time of the invention was made to provide a session loss prevention to the terminal in the event failure.

Regarding claim 38, it would have been explicit to one of ordinary skill in the art at the time of the invention was made to configure the processor to perform data protocol conversion.

Art Unit: 2731

Regarding claim 39, it would have been explicit to one of ordinary skill in the art at the time of the invention was made to configure the processor responding to a request on a remote resource which was cached locally in the translator, gateway or router.

Regarding claim 40-42, it is designer choice for providing a file synchronization across the communication system, performing database synchronization among a plurality of terminals and providing e mail with file replication and reconciliation without the terminal having to request replication or reconciliation.

Regarding claim 43, it would have been explicit to one of ordinary skill in the art at the time of the invention was made to read the routing table of translator wherein the first address is pair with second address and replacing the first address with second address as a destination address in order to route the data packet to its destination.

Regarding claim 44, it would have been explicit to one of ordinary skill in the art at the time of the invention was made to replace the second address with the first address as source address to forward incoming data to its destination.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 2731

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

7. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Egevang (RFC 1631) as applied to claim 1 above, and further in view of Perkins (USP 5412654).

Regarding claim 36, Egevang fail to disclose the processor which configures to perform dynamic creation and maintenance of a wireless network with capability to route a data packet across multiple wireless hops transparently to the terminal. However, in the same field of endeavor, Perskins discloses the processor which configures to perform dynamic creation and maintenance of a wireless network with capability to route a data packet across multiple wireless hops transparently to the terminal.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply the teaching of Perskins such as configuring the processor of mobile host transmitting a data packet across multiple wireless hops into the communications system of Egevant in order to transmit a data packet across a multiple wireless hops.

Art Unit: 2731

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Okanoue et al (USP 5841769) disclose a method for routing a data packet by replacing the destination address.

Patrick et al (USP 5790541) disclose a method for encapsulating the MAC address of the router into data packet.

Okanoue et al (USP 5862345) disclose a method for routing a data packet to mobile host without using home router.

Toth (USP 5708665) disclose a method for address a wireless communication with a dynamically assigned address wherein the mobile host having a permanent address.

Kraemer et al (USP 5798706) disclose a packet which transmits to its destination by using the hardware address.

Attanasio et al (USP 5371852) disclose a method for configuring a gateway as a single host on a network by replacing the source address of the outgoing data packet with its address.

Fox et al (USP 5636216) disclose a method for translating Internet address to other distributed network address schemes.

Perkins (USP 5159592) disclose a method for network address management.

Art Unit: 2731

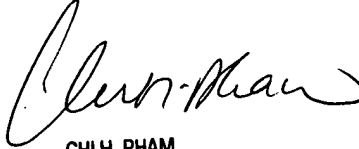
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Nguyen whose telephone number is (703) 308-8848. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi Pham, can be reached on (703) 305-4378.

The fax phone number for this group is (703) 305-3988.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Steven Nguyen
Art Unit 2731
April 27, 1999


CHI H. PHAM
SUPERVISORY PATENT EXAMINER
GROUP 2700 7/30/99